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APPLICATION NO. 097072,342	FILING DATE 02/19/98	FIRST NAMED INVENTOR TSUDA	ATTORNEY DOCKET NO. S
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COOPER & DUNHAM
JAY H MAIOLI
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036

MM41/0527

EXAMINER LE, H

ART UNIT 2821	PAPER NUMBER 4
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DATE MAILED: 05/27/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/072,342

Applicant(s)

TSUDA ET AL

Examiner

HOANGANH LE

Group Art Unit

2821



☒ Responsive to communication(s) filed on Feb 19, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-5, 7-10, and 16-19 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5, 7-10, and 16-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. The amendment filed on February 19, 1998 is acknowledged.
2. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second antenna of claim 1, and the external antenna of claims 7 and 19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, "said external apparatus" has no antecedent basis.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by the Prior Art (figure 1).

The Prior Art (figure 1) teaches an antenna coupling apparatus comprising a first antenna 6 connected to a portable radio terminal, the first antenna 6 being elongated in an axial direction; a second antenna separated from the first antenna; an electromagnetic coupling element 2 consisting of a conductor that electromagnetically couples the first and the second antennas together arranged adjacent to the first antenna 6 at a first location along the axial direction of the first antenna 6; a ground conductor element 4 arranged proximate the first antenna 6; and a reflective ground element 4 arranged adjacent to the first antenna 6 and disposed a predetermined distance from the electromagnetic coupling element 2 along the first antenna 6 in the axial direction for

reflecting power transmitted from or received by the first antenna toward the electromagnetic coupling element.

8. Claims 1-5, 7-10, and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Pottala et al (the US Patent No. 5,557,287).

The Pottala et al reference teaches in figure 2 an antenna coupling apparatus comprising a first antenna 195 connected to a portable radio terminal 190, the first antenna 195 being elongated in an axial direction; a second antenna 187 separated from the first antenna 195; an electromagnetic coupling element 240 consisting of a conductor that electromagnetically couples the first and the second antennas together arranged adjacent to the first antenna 195 at a first location along the axial direction of the first antenna 195; a ground conductor element 230 arranged proximate the first antenna 195; and a reflective ground element 210, 230 arranged adjacent to the first antenna 195 and disposed a predetermined distance from the electromagnetic coupling element 240 along the first antenna 195 in the axial direction for reflecting power transmitted from or received by the first antenna toward the electromagnetic coupling element. Figure 2 shows the electromagnetic coupling element and the reflective ground element are in the form of a trough with a U-shaped cross section.

9. Claims 1, 3-5, 7-10, and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Perrotta et al (the US Patent No. 5,668,561).

The Perrotta et al ('561) reference teaches in figures 1 and 2 an antenna coupling apparatus comprising a first antenna 204 connected to a portable radio terminal 202, the first antenna 204 being elongated in an axial direction; a second antenna 124 separated from the first antenna 204; an electromagnetic coupling element 110 consisting of a conductor that electromagnetically couples the first and the second antennas together arranged adjacent to the first antenna 204 at a first location along the axial direction of the first antenna 204; a ground conductor element 112, 122, 108 arranged proximate the first antenna 204; and a reflective ground element 106, 108 arranged adjacent to the first antenna 204 and disposed a predetermined distance from the electromagnetic coupling element 110 along the first antenna 195 in the axial direction for reflecting power transmitted from or received by the first antenna toward the electromagnetic coupling element.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be

used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-5, 7-10, and 16-19 are rejected under the judicially created doctrine of double patenting over claims 1-6 of U. S. Patent No. 5,777,585 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a first antenna, a second antenna, an electromagnetic coupling element, a ground conductor element, and a reflective ground element.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Correspondence

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Hoanganh Le whose telephone number is (703) 308-4921.

13. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0956.

14. Papers related to Technology Center 2800 applications **only** may be submitted to Technology Center 2800 by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "DRAFT". The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center Fax Center number is (703) 308-7722 or (703) 308-7724.

Hoanganh Le
Primary Examiner
Art Unit 2821
May 24, 1999


Hoanganh Le
Primary Examiner